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09/975,386	10/11/2001	Kenneth David Knapp	24-01	1255
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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/975,386
Filing Date: October 11, 2001
Appellant(s): KNAPP, KENNETH DAVID

John F. McNulty
For Appellant

SUPPLEMENTAL EXAMINER'S ANSWER

This is in response to the Remand by the Board of Appeal of 11/21/05 and appeal brief filed
03/09/2005 appealing from the Office action mailed 6/4/2004.

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(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,444,289	ERNEST	09-2002
4,709,523	BRODERICK ET AL	12-1987
649,363	RYAN	05-1900

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claims 1-2, 4, 8 are rejected under 35 U.S.C. 102(e) as being anticipated by Ernest (6444289).

Ernest (figure 2) shows a blanket of fibrous building insulating comprising a fibrous insulation layer (18) of a predetermined thickness having opposite first and second insulation surfaces between side surfaces that are spaced apart a given dimension which first and second insulation surfaces define the predetermined thickness, a thin facing sheet (20) having first and second sheet surfaces spaced apart a dimension that is substantially less than the predetermined

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thickness determined by the spacing apart of the insulation first and second surfaces with the first sheet surface thereof disposed on a second insulation surface (18a) of the insulation layer, a thin adhesive layer (24) substantially thinner than the thickness of the insulation layer disposed between and securing the first sheet surface of the facing sheet to the second insulation surface of the insulation layer, a grid of perforations (26) through the facing sheet, spots of adhesive visible through the perforations at the second sheet surface of the facing sheet (col 4 line 15-17), the grid of perforations comprising means defining generally straight predetermined cut lines for cutting the facing sheet and insulation in accordance with a pattern defined by at least some of the spots of adhesive, the blanket of insulation may be readily be cut along a line of the spots of adhesive to accommodate spaces between spaced apart structural members of lesser spacing than the given dimensions (inherently so), the insulation layer being of fiberglass construction (col 3 line 26-27), the grid of perforations being of rectangular, intersecting horizontal and vertical lines of spaced apart perforations, the grid of perforations comprising four vertical, generally spaced apart cut lines, the grid of perforations comprising horizontal, generally parallel, spaced apart cut lines.

Per claim 8, Ernest shows all the claimed method steps of making a blanket of fibrous building insulation. Ernest's structure also inherently can function as claimed.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ernest (6444289) in view of Broderick et al (4709523).

Ernest shows all the claimed limitations except for the adhesive being asphalt.

Broderick et al discloses asphalt adhering an insulation layer (18) to a covering layer (11).

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Ernest to show the adhesive being asphalt because asphalt would provide strong bond between an insulation layer and its cover as taught by Broderick et al.

5. Claims 5-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ernest (6444289).

Ernest shows all the claimed limitations except for the grid of perforation having cut lines being approximately 3 inches apart between side surfaces of the insulation layer, the grid of perforations having cut lines approximately 3.75 inch apart between side surfaces of the insulation layer, the grid of perforations having horizontal cut lines approximately 1.5 inch apart.

It would have been an obvious matter of design choice to show the grid of perforation having cut lines being approximately 3 inches apart between side surfaces of the insulation layer, the grid of perforations having cut lines approximately 3.75 inch apart between side surfaces of the insulation layer, the grid of perforations having horizontal cut lines approximately 1.5 inch apart because it would have been an obvious matter of design choice to show the perforations having cut lines approximately 3, 3.75, or 1.5 inch apart since applicant has not disclosed that the various spacing dimensions solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well with the perforations being spaced apart

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any desired dimension, and the fact that it is a matter of design choice is further illustrated by applicant's claims which call for the variety of dimensions between perforations.

6. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ernest (6444289) in view of Ryan (649363).

Ernest shows all the claimed method steps except for the step of fastening a portion of the cut blanket of fibrous building insulation in the predetermined spacing between structure members.

Ryan (figure 1) shows the step of fastening a portion of the cut blanket of fibrous building insulation in the predetermined spacing between structure members.

7. It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Ernest to show the step of fastening a portion of the cut blanket of fibrous building insulation in the predetermined spacing between structure member because the step would allow the insulation blanket to cover the spacing between structure members as taught by Ryan.

(10) Response to Argument

Applicant's arguments filed 3/9/05 have been fully considered but they are not persuasive.

With respect to applicant's arguments that Examiner modifies reference and thus making the reference inoperable, examiner would like point out the following. First of all, claims 1-2, 4 and 8 are rejected under 102(e). Examiner rejects the claims based on the reference as is, without modifying the reference. The reference shows all the claimed structural limitations. Secondly, examiner is unclear why applicant states that examiner wants to clog the holes of Ernst

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so that Ernst cannot vent the high static pressure. Examiner has done no such thing. The claims are rejected based on the teachings of the reference Ernst, not any modification thereof. Thirdly, by not modifying the reference as stated by applicant, examiner has not gone against the teaching of any Federal Circuit Court decision.

With respect to applicant's statement that there is no teaching of using the perforations 26 of Ernst as cut guidelines, examiner respectfully disagrees. As shown by the reference, the perforations function as guidelines for a person by the way the perforations are lined up. The very way that the perforations are positioned on the panel satisfies the claimed limitations. Examiner is not yet modifying any teaching of Ernst.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In response to applicant's arguments, the recitation of intended use (for installation in ...that are irregularly spaced apart" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or

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structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

In response to applicant's argument that the intended use "for installation...irregularly spaced apart" in the preamble needs to be given patentable weight, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963).

Applicant also states that the intended use gives "life and meaning " to the claim, examiner respectfully disagrees. As pointed out specifically to claim 1, the claim is to a blanket of fibrous building insulation, and not a combination with any building structural members. The blanket has many other potential usages, with "installation...spaced-apart structural members" being one of them. The blanket is a finished structure by itself and not needing other "unclaimed" structural limitations to give life and meaning to the structure. The reference itself also inherently shows the claimed functional language as set forth above. The argument is thus moot.

The arguments to claims 2-4 are thus moot per the argument to claim 1 above.

With respect to claims 5-7 to the various dimensions for the spacing of the cut lines, examiner as set forth above that these various dimensions are an obvious matter of design choice as applicant has not stated the dimensions solves any stated problem or is for any particular

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purpose, and the fact that the dimensions are design choice is further illustrated by applicant's claims to the different dimensions between the perforations. With respect to applicant's now argument that the dimensions serve a specific purpose to define five zones of insulation to fit between studs that are 16 inches apart on centers, examiner respectfully points out the following. As disclosed in applicant's specification page 8 last paragraph, the spacing of the studs are commonly of non-standard dimensions, and the blankets being of different possible dimensions, applicant's argument that the dimensions serve a specific purpose to define five zones of insulation is thus inconsistent with the disclosure which states that the dimensions are not critical. The dimensions are thus a matter of design choice as a variety of dimensions may function the same as claimed. The argument is thus moot.

With respect to claim 8, examiner points out that the reference discloses a thin layer of adhesive being applied to a surface of the facing material, the adhesive being visible through the perforations (the adhesive thus bleed into the perforations, otherwise it would not be visible). The argument is thus moot.

The argument is claim 9 is moot in view of the rejection set forth above. Furthermore, the claim is rejected by Ernst in view of Ryan. Ryan shows a blanket being fastened in the predetermined spacing between structural members as set forth above. The combination thus teaches the claimed limitations. The argument is thus moot.

For the above reasons, it is believed that the rejections should be sustained.

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(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

Respectfully submitted,

Phi Dieu Tran A *PA*

December 13, 2005

Conferees

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